

## **REMARKS**

### **STATUS OF THE CLAIMS**

Claims 1-76 were pending in the application as filed. New claims 77-86 were added. Following entry of the amendments, claims 1-86 will be pending and at issue.

### **SUPPORT FOR AMENDMENT TO THE CLAIMS**

New claims 77-86 have been added to claim species of the claims on which the new claims depend. Support can be found throughout the specification as filed, e.g., the claims as filed. The amendments to the claims therefore add no new matter and entry is respectfully requested.

### **SPECIES ELECTION**

The Examiner stated that the claims are directed to more than one species of the generic invention and that the species lack unity of invention under PCT Rule 13.1. The Examiner stated that Applicant is required to elect one species from each of nine (9) categories to which no generic claim is finally held to be allowable. The Examiner stated that upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitation of an allowed generic claim. The Examiner stated that the following claims are generic: claims 1-3, 9-17, 21, 23-31, 33-34, 38, 42-45, 51-53, 58-62, 65, 67-70, and 72-76.

Applicant responds to the nine species election as follows:

Category A: carrier protein domain (claims 4-7 and 54-57)

Species A-1: PK synthase

Species A-2: NRP synthase. If this species is elected, applicant must also choose whether the NRP synthase domain comprises PCP, ArCP, and/or ACP activity (please specify the combination if more than one activity is selected).

Species A-3: FA synthase

Justification: Each synthase comprises a chemically distinct structure and special technical feature.

Office Action at 2.

In response, Applicant elects a NRP synthase (Species A2) without traverse.

Applicant further elects PCP (peptidyl carrier protein) activity. Claims 1-4, 6, 8-54, 56, 58-86 read on the elected species.

Category B: biosynthetic enzyme hybrid (claim 8)

Category B-1: FA synthase

Category B-2: PK synthase

Category B-3: NRP synthase

Category B-4: A combination of Species B-1, B-2, and B-3 (please specify)

Justification: Each synthase comprises a chemically distinct structure and special technical feature.

Office Action at 2-3.

Applicant notes that claim 8 depends from claim 3, wherein the protein of interest is a biosynthetic enzyme. In response, Applicant elects without traverse a biosynthetic enzyme that is a hybrid, e.g., combination of a FA synthase, a PK synthase, and a NRP synthase (Category B-4). Claims 1-86 read on the elected species.

Category C: reporter type or precursor reporter type (claims 18, 20 and 63-64)

Category C-1: affinity reporter

Category C-2: colored reporter

Category C-3: fluorescent reporter

Category C-4: magnetic reporter  
Category C-5: radioisotopic reporter  
Category C-6: peptide reporter  
Category C-7: metal reporter  
Category C-8: nucleic acid reporter  
Category C-9: lipid reporter  
Category C-10: glycosylation reporter  
Category C-11: reactive reporter

Justification: Each reporter comprises a chemically distinct structure and special technical feature.

Office Action at 3.

In response, Applicant elects a fluorescent reporter (claim 18, claim 63) or a precursor to a fluorescent reporter (claim 20 or 64) (Category C-3) without traverse. Claims 1-86 read on the elected species.

Category D: synthetic appendage label (claim 19)

Category D-1: protein chip immobilization label  
Category D-2: two-hybrid or three-hybrid analysis label  
Category D-3: trace purification label

Justification: Each label comprises physically different properties and special technical features.

Office Action at 3-4.

In response, Applicant elects a trace purification label (Category D-3) without traverse. Claims 1-86 read on the elected species.

Category E: secondary molecule (claims 22 and 66)

Category E-1: carbohydrate  
Category E-2: peptide  
Category E-3: oligonucleotide  
Category E-4: synthetic reporter

Justification: Each reporter precursor comprises a chemically distinct structure and special technical feature.

Office Action at 4.

Applicant respectfully points out that although the Office Action recites “synthetic reporter,” claims 22 and 66 recite “synthetic receptor.” In response, Applicant elects a synthetic receptor (Category E-4) without traverse. Claims 1-86 read on the elected species.

Category F: molecular weight determination technique (claim 32)

Category F-1: gel electrophoresis

Category F-2: affinity chromatography

Category F-3: mass spectrometry

Category F-4: synthetic reporter

Justification: Each technique operates under different principles and comprises different special technical features.

Office Action at 4.

Applicant respectfully points out that there is no synthetic reporter recited in claim 32. In response, Applicant elects gel electrophoresis (Category F-1) without traverse. Claims 1-86 read on the elected species.

Category G: method type (claims 35-37 and 71)

Category G-1: Assay expression/activity for protein of interest (claims 35 and 37)

Category G-2: Screen for proteins of interest (claims 36 and 71)

Justification: Each technique (i.e. assay vs. expression) operates under different principles and comprises different special technical features.

Office Action at 4-5.

In response, Applicant elects a screen for proteins of interest (Category G-2) without traverse. Claims 1-34, 36, and 38-86 read on the elected species.

Category H: applications (claims 39-41)

Category H-1: cell

Category H-2: cell-line

Category H-3: organism

Category H-4: class of organism

Justification: Each living body constitutes differing forms of life with different special technical features.

Office Action at 5.

In response, Applicant elects a cell (Category H-1) without traverse. Claims 1-86 read on the elected species.

Category X: removal method of synthetic appendage (claims 46-50)

Species X-1: light (claim 46)

Species X-2: heat (claim 47)

Species X-3: chemical reagent (claim 48)

Species X-4: enzymatic (claims 49-50)

Justification: Each method of removing appendages operates under different physical principles and special technical features.

Office Action at 5.

In response, Applicant elects a chemical reagent (Category X-3) without traverse. Claims 1-45, 48, and 51-86 read on the elected species.

## **STATEMENT OF SUBSTANCE OF INTERVIEW**

Applicant thanks the Examiner for his time during a telephone interview on Wednesday, May 26, 2010. Present for the interview were Examiner Negin and Applicant's representatives, Attorney Michelle Lee and Attorney Melissa Harwood. No exhibits or demonstrations were presented or discussed. During the interview, the lack of unity of invention rejection for claims 1-76 were discussed.

## CONCLUSION

Consideration of the claims is respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this response, the Examiner is invited to telephone Applicants' representative at (206) 389-4596.

Respectfully Submitted,

Dated: June 30, 2010

By: /Andrew T. Serafini/  
Andrew T. Serafini  
Registration No. 41,303  
FENWICK & WEST LLP  
801 California Street  
Mountain View, CA 94041  
Phone (206) 389-4596  
Fax (650) 938-5200